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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,298	04/24/2001	Scott Lee Wellington	5659-06900/EBM	3893

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EXAMINER	
JOHNSON, JERRY D	

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/841,298	WELLINGTON ET AL.	
	Examiner	Art Unit	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 February 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4365-4424* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4365-4424* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *February 28, 2005* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4365-4424 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Terry.

Terry, U.S. Patent 4,099,567, teaches a product produced from a coal formation comprising cracked gases of pyrolysis. The product reasonably appears to be either the same as or an obvious variation of the instantly claimed product because the product of Terry is also produced from a coal formation and in a similar way as compared to the claimed product. See column 2, lines 54-68 and column 5, lines 38-44 of Terry.

In the event any difference can be shown for the product of claims 4365-4424, as opposed to the product taught by Terry, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4365-4424 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

To the extent it could be argued that the claimed composition is novel or unobvious, the claimed subject matter has not be described in the specification in such a way as to enable one

skilled in the art to make and/or use the invention, i.e., coal formations differ in chemical composition and applicants have not identified the chemical characteristics of the coal formation from which the claimed product is derived.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 4365-4424 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4184-4224 and 4242-4280 of copending Application No. 09/841,127. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,127 to obtain the product of the present application by choosing component amounts with the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4365-4424 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4281-4302 and 5150-5159

of copending Application No. 09/841,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,129 to obtain the product of the present application by choosing component amounts within the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 4365-4424 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4188-4284 of copending Application No. 09/841,310. Although the conflicting claims are not identical, they are not patentably distinct from each other because each set of claims appears to be drawn to products that have the same components in overlapping amounts. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the claims in 09/841,310 to obtain the product of the present application by choosing component amounts within the claimed ranges.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

Applicants argue "the product of Terry is not produced in a similar way as compared to the claimed product. Terry appears to use a flame front to heat the coal formation" (Remarks,

page 14). Applicants further argue "applicant's [sic] specification, however, describes heating the coal formation with heat sources and heaters. Applicant submits that it is not obvious to one of ordinary skill in the art that products obtained from a coal formation heated with a flame front would be the same as or an obvious variation of the claimed product." (Remarks, page 15). Applicants' arguments lack merit.

Terry teaches a product produced from a coal formation comprising cracked gases of pyrolysis. The product reasonably appears to be either the same as or an obvious variation of the instantly claimed product because the product of Terry is also produced from a coal formation and in a similar way (i.e., by heating the formation) as compared to the claimed product. Where the claimed product and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

On page 17 of the response, applicants disagree with the rejection under 35 U.S.C. §112 and argue "that suitable hydrocarbon formations are described at least from line 26 to page 41 through line 29 of page 45 of the Specification."

Pages 41 through 45 of the specification describe various basis by which coal formations may be selected. For example, page 41, lines 26-29 teach

> [c]oal formations may be selected for in situ treatment based on properties of at least a portion of the formation. For example, a formation may be selected based on richness, thickness, and depth (i.e., thickness of overburden) of the formation. In addition, a formation may be selected that will have relatively high quality fluids produced from the formation.

While the specification teaches various basis by which coal formations may be selected, the instant claims are directed to hydrocarbon compositions having specifically claimed properties. Coal formations differ in chemical composition and applicants have not identified the properties of the coal formation from which products having the specifically claimed properties are derived.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jerry D. Johnson
Primary Examiner
Art Unit 1764

jdj